

RESPONSE TO NOTICE OF NOT FULLY RESPONSIVE REPLY
Attorney Docket No.: Q76461
U.S. Application No. 10/614,044

REMARKS

Claims 1, 2, and 4-25 are all the claims pending in the application. Claims 1 and 4 are amended. Claims 6-25 are newly added. Claim 3 is canceled.

Specification Objections

The Examiner asserts that the title of the invention is not descriptive. Applicant hereby amends the title to read “DIGITAL VIDEO CAMERA FOR MOTION AND STILL PICTURE IMAGING.” Applicant submits that this title is clearly indicative of the invention to which the claims are directed. Applicant therefore respectfully requests that the Examiner withdraw this objection.

Claim Objections

The Examiner objects to claim 4, asserting that use of the phrase “adapted for” in claim 4 suggests or makes optional, but does not require, steps to be performed. Applicant submits that claim 4 as amended is not objectionable. Applicant therefore respectfully requests that the Examiner withdraw the objection.

Claim Rejections Under 35 U.S.C. § 103

A. Claims 1 and 3

Claims 1 and 3 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Published U.S. Patent Application No. 2002/0063783 A1 to Kurase (“Kurase”) in view of U.S. Patent No. 6,295,088 B1 to Tsukahara et al. (“Tsukahara”). Claim 3 is hereby canceled, and its matter incorporated into claim 1. Applicant traverses this rejection for at least the following reasons.

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The Examiner asserts that Tsukahara teaches a “shutter button” as required by amended claim 1. Amended claim 1, however, requires “a shutter button disposed in the center of the upper face of said camera body.” The figure of Tsukahara cited by the Examiner clearly shows that the “release button 218,” which the Examiner relates to the “control button” of amended claim 1, is not “disposed in the center,” but instead is disposed toward an edge of the surface, toward the “side face 255.” (Tsukahara at Fig. 14.) The Examiner also cites a portion of Tsukahara which states that “[a] release button 218 and a zooming button 219 are also positioned side by side in this order at a position closer to the side face 255.” (Tsukahara at col. 14, ll. 38-44.)

Thus, the portion of Tsukahara cited by the Examiner fails to teach or suggest this element of amended claim 1; moreover, the deficiency of Tsukahara in this regard is not remedied by Kurase. Amended claim 1 is therefore patentable over Tsukahara and Kurase, whether applied alone or in combination. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

Furthermore, since neither Steinberg nor Suzuki remedy the above-described deficiency of Tsukahara, Applicant submits that dependent claims 2 and 4-5 are also patentable over the applied references. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 2 and 4-5.

B. Claim 2

Claim 2 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kurase in view of Tsukahara, and further in view of U.S. Patent No. 6,750,902 B1 to Steinberg et al. (“Steinberg”). Applicant traverses this rejection for at least the following reasons.

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Applicant first submits that claim 2 is patentable over Kurase, Tsukahara, and Steinberg, alone or in combination, at least for the reasons set forth above regarding claim 1.

The Examiner asserts that a motivation to combine Kurase and Tsukahara in view of Steinberg is “to increase the portability of the camera by reducing its size and to reduce the power consumption by taking advantage of the low power consumption of the Clik! drive.” Applicant must emphasize that claim 2 does not require use of a “Clik!” disk, but rather a “removable flexible disk [having] a diameter of less than or equal to 50.8mm (2 inches).”

Moreover, Kurase and Tsukahara appear to teach use of a “compact flash,” (Kurase at ¶ [0055]) and a “memory card,” (Tsukahara at col. 14, ll. 2-3) respectively, which appear to refer to solid-state memory cards. In light of these teachings of Kurase and Tsukahara, and taking these three references as a whole, Applicant submits that it would not have been obvious to one of ordinary skill in the art at the time of invention that using a “removable flexible disk,” as required by claim 2, would have reduced either the size or power consumption of the device taught in Kurase. Therefore, Applicant respectfully submits that the Examiner’s purported motivation to combine is insufficient to create a *prima facie* case of obviousness with respect to claim 2. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

C. Claims 4 and 5

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kurase in view of Tsukahara, and further in view of U.S. Patent No. 5,634,162 to Suzuki (“Suzuki”). Applicant traverses this rejection for at least the following reasons.

With respect to claim 4, the Examiner asserts that when the time expires in the timer shown in Suzuki, the camera changes from still image recording to video recording. The

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Examiner refers to Fig. 4, steps S111 and S114 of Suzuki in relation to the limitations of claim 4.

Step S111, however, shows a step determining whether a predetermined time has expired in the timer. If the time has expired, video recording is continued (S114), whereas if the time has not expired, the system continues to check whether the “video trigger” has been pressed (S110). The entire process shown in Fig. 4 is performed “during video recording,” as shown in S101. Thus, the only resultant action of the entire process of Fig. 4 of Suzuki is either to continue or to stop video recording. This is clearly completely different from the requirement of amended claim 4 that the “imaging means switches said imaging between still and motion picture images based on the duration of time,” as no such switching occurs in the cited portions of Suzuki.

With respect to claim 5, Applicant submits that Suzuki cannot be combined with Kurase and Tsukahara as suggested by the Examiner, so as to render claim 5 unpatentable. Suzuki appears to be directed to a device having a still image camera attached to a motion picture camera, with separate control buttons for each camera. Suzuki further appears to be directed to a problem wherein a user mistakenly depresses one control button while intending to depress the other.

Suzuki does not appear to “obtain[] a still image” or “a motion picture” based on “the duration of time for which said shutter button is pressed down,” as required by claim 5. Nowhere does Suzuki appear to describe any function or act based on such a “duration of time.” Although Suzuki does contain timer steps such as those taught in Figs. 4 and 5, these timers merely appear to block certain functions of the buttons for a predefined period of time. Moreover, Suzuki fails to contemplate that either button is pressed down for more than a momentary duration of time, or that such duration has any significance.

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To the extent that Suzuki takes into account the timing features in the video recording mode and an error determined by the timing of button activation, such recording is different than that described by claim 5. Claim 5 discusses still capturing when “the duration of time for which said shutter button is pressed down” is “less than a predetermined time period.” In Suzuki, the operation starts in a moving capture mode, and any change in mode must occur after a lapse of time.

Since Kurase, Tsukahara, and Suzuki, alone or in combination, fail to teach or suggest the elements of claims 4 and 5, claims 4 and 5 are patentable over these references. Moreover, Applicant submits that claim 5 is patentable at least by virtue of its dependence from claim 4. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

New Claims

Applicant hereby adds new claims 6-21 in order to more fully claim the disclosed invention. Applicant submits that, at least for reasons analogous to those presented above, and because the references cited by the Examiner fail to teach or suggest any matter claimed in claims 6-21 that is not also claimed in claims 1-2 or 4-5, new claims 6-21 are patentable over the cited references. Furthermore, Applicant submits that claims 6-21 are each fully supported by the disclosure of the present invention, and contain no impermissible new matter.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Applicant herewith petitions the Director of the USPTO to extend the time for reply to the above-identified Office Action for an appropriate length of time if necessary. Unless a check is attached, any fee due under 37 U.S.C. § 1.17(a) is being paid via the USPTO Electronic Filing System (EFS). The USPTO is also directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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